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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,679	11/21/2003	Steve Mundy	018360/269090	1310

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EXAMINER
KRAMER, JAMES A

ART UNIT	PAPER NUMBER
3692	

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 September 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14,17-34,38-49 and 51-58* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14,17-34,38-49 and 51-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>JUL 03, 2006</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

The amendment filed 9/8/06 includes a claim identifier for claim 49 which appears to be

incorrect. Particularly, it identifies claim 49 as "(currently amended)". As claim 49 does not

contain an amendment, Examiner believes is should say, "(previously presented)."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 14, 17-34, 38-49 and 51-58 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Williams et al. in view of Commerce One

Williams et al. teaches an apparatus, system and method for online, multi-parcel, multi-

carrier, multi-service enterprise parcel shipping management.

With respect to **Claim 14**, Williams et al. teaches providing a selectable list of suppliers

to a user via a buyer interface of an electronic procurement system wherein said electronic

procurement system is configured according to an established procurement policy (see for

example page 2 paragraph 0017); allowing said user to purchase one or more goods from one or

more of said suppliers via the electronic procurement system and offering shipping services to

the user via the electronic procurement system upon the user selecting the shipping carrier from

the list of suppliers (see page 3, paragraph 0021).

Examiner notes that the comparison array of Williams et al. represents Applicant's selectable list.

Further, Examiner notes that Applicant fails to set forth a clear and definite definition for an electronic procurement system. Based on Applicant's specification and in particular the "Description of Related Art" Examiner interprets an electronic procurement system as a computerized system, within a company developed to alleviate the hassles that can be associated with maintaining a business procurement policy and to maximize access to data regarding business purchases (Specification, page 2, paragraph 0008, lines 1-3). Examiner notes that the system of Williams et al. meets this interpretation (for example see page 3, paragraph 0029).

Williams does not specifically teach where in the system allows for the purchase of tangible goods and for shipping services.

Commerce One teaches a buyer procurement application configured to list preferred suppliers of goods and services, execute purchase transactions, and record transaction information regarding purchases made including but not limited to descriptions of the products or services purchased, an identification of the employee who made the purchase, the price of the purchase and the time of the purchase (see Applicant's Specification page 7, paragraph 36, lines 3-8 and website for Commerce One Buy submitted by Examiner from archive.org's WayBack Machine).

Examiner notes that at the time of the present invention it would have been obvious to one of ordinary skill in the art at the time of the invention to add the shipping services of Williams to the buyer procurement application of Commerce One. One of ordinary skill in the art would have been motivated to make such a modification in order to reduce purchasing conts

of shipping services to improve a company's bottom line (see Commerce One page 5 of 8, 1st paragraph).

With respect to **Claims 17 and 18**, Williams et al. teaches generating a shipping label; and returning a shipping label to the buyer interface; wherein the step of generating a shipping label comprises providing the ship to address, and the level of service to a shipping carrier tracking application (see page 3, paragraphs 0020-0025).

With respect to **Claims 19 and 20**, Williams et al. teaches wherein the electronic procurement system comprises a buyer procurement server, a shipping carrier procurement services server and a commerce services server (see Figure 3). Examiner notes that the Enterprise User Computers represent buyer procurement server. Further the system data center represents commerce services server and the carriers' servers represent shipping carrier procurement services server.

With respect to **Claims 21 and 22**, Williams et al. teaches sending user data from the buyer procurement server to a commerce services server and sending user data from the commerce services server to the shipping services procurement server upon user selecting the shipping carrier from the list of suppliers (see Figure 3 and page 6, paragraphs 0101 through 0109).

Examiner notes the Enterprise User Computers (8a-8n) represent Applicant's buyer

procurement server. Additionally, the Firewall/Proxy servers (21a-21k) represent Applicant's

commerce servers, as all information from the Enterprise user/buyer is filtered through these

servers. Finally, the Web Farm (21m-21r) represents Applicant's shipping services procurement

server (see page 6, paragraph 0101, lines 4-8)

Examiner further notes that user information is passed from the Enterprise system (buyer

procurement servers) through the firewall/proxy servers (commerce servers) to the System

(shipping services procurement server) in order to rate a shipment and thus allow selection by the

user of the shipping company (see 8. Shipment Rating starting on page 13, paragraph 0252).

With further respect to **claims 21 and 22**, Williams et al also teaches sending a startup

URL from the shipping carrier procurement services application to the buyer procurement

application (see Figure 7).

Examiner notes the similarity between Williams et al.'s Figure 7 and Applicant's Figure

3, described in the Specification on page 9, paragraph 0041, lines 1-7.

With respect to **Claim 23**, Williams et al. teaches wherein the user data comprises: a user

identifier, a buyer company identifier, a return URL and a session identifier (see page 21,

paragraphs 0347 and 0348) (page 23, paragraph 0377 through page 24, paragraph 0389).

Examiner notes that when a user logs into the shipping rules are set for the user system

(see page 11, paragraphs 0192-0194). Examiner notes that this represents passing user and buyer

company identifier. Further, Williams et al.'s PID represents Applicant's session ID. Lastly the

create a link feature represent the return URL used to return transaction information back to the user.

With respect to **Claim 24**, Williams et al. teaches sending transaction data to the buyer procurement server from the shipping carrier procurement services server, the data being sent to location referred to by the return uniform resource locator (see page 23, paragraph 0377 through page 24, paragraph 0389). Examiner notes, as was discussed with respect to claim 23, the create a link feature returns transaction information embedded in a URL to the users.

With respect to **Claim 25**, Williams et al. teaches wherein the user data further comprises: a unique buyer key; and a supplier company identifier. Examiner once again notes that when a user logs into the shipping rules are set for the user system (see page 11, paragraphs 0192-0194). Examiner notes that these rules include shipper identifiers which identify the shippers available to a particular user. Further, Examiner notes that a user name represents a unique buyer key.

With respect to **Claim 27**, Williams et al. teaches wherein the user data comprises: a user identifier; a buyer company identifier; a return uniform resource locator; and a session identifier (see page 21, paragraphs 0347 and 0348) (page 23, paragraph 0377 through page 24, paragraph 0389).

Examiner notes that when a user logs into the shipping rules are set for the user system (see page 11, paragraphs 0192-0194). Examiner notes that this represents passing user and buyer

company identifier. Further, Williams et al.'s PID represents Applicant's session ID. Lastly the

create a link feature represent the return URL used to return transaction information back to the

user.

With respect to **Claim 28**, Williams et al. teaches wherein the user data further

comprises: a supplier company identifier. Examiner once again notes that when a user logs into

the shipping rules are set for the user system (see page 11, paragraphs 0192-0194). Examiner

notes that these rules include shipper identifiers which identify the shippers available to a

particular user. Further, Examiner notes that a user name represents a unique buyer key.

With respect to **Claim 29**, Williams et al. teaches wherein the user data further

comprises: a unique buyer key, and a unique supplier key, the unique buyer key being sent from

the procurement server to the commerce services server and the unique supplier key being sent

from the commerce services server to the shipping carrier procurement services server (see page

21, paragraphs 0347 and 0348) (page 23, paragraph 0377 through page 24, paragraph 0389).

Examiner notes that when a user logs into the shipping rules are set for the user system

(see page 11, paragraphs 0192-0194). Examiner notes that this represents passing a buyer key.

Examiner notes that these rules further include shipper identifiers which identify the shippers

available to a particular user.

With respect to **Claim 31 and 32**, Williams et al. teaches wherein the startup uniform

resource locator contains embedded values comprising a user identifier, a buyer company

identifier, and a session identifier. (see page 23, paragraph 0377 through page 24, paragraph

0389). Examiner once again notes that the PID represents the session identifier, which relates

back the the logged in user and buyer company and as such includes that information embedded

in the URL.

With respect to **Claim 33,** Williams et al. teaches directing a browser application on the

buyer interface to the startup uniform resource locator (see Figure 7).

Examiner notes the similarity between Williams et al.'s Figure 7 and Applicant's Figure

3, described in the Specification on page 9, paragraph 0041, lines 1-7.

With respect to **Claim 34,** Williams et al. teaches enabling the user to specify package

shipping data including a ship to address, a package weight, and a level of service (see page 21,

paragraph 0347).

With respect to **Claims 38 and 39,** Examiner finds them substantially similar to the

claims above and therefore they are not patentable distinct. Examiner relies on the analysis

above for claims 38 and 39.

With respect to **Claim 40-46,** Examiner finds them substantially similar to the claims

above and therefore they are not patentable distinct. Examiner relies on the analysis above for

claims 40-46.

With respect to **Claim 47-58**, Examiner finds them substantially similar to the claims

above and therefore they are not patentable distinct. Examiner relies on the analysis above for

claims 407-58.

Response to Arguments

Applicant's arguments filed 9/8/06 have been fully considered but they are not

persuasive.

Applicant asserts that the prior art fails to teach integrating shipping services with an

electronic procurement system such that a user can purchase shipping services in addition to

tangible goods (see for example Remarks/Arguments submitted 9/8/06 paragraph briding pages

10 and 11 and page 11, third full paragraph). Examiner respectfully disagrees.

It is the position of the Examiner that Williams teaches the ability to sell shipping

services in the same manner as tangible goods and services (i.e. over the internet via an

electronic procurement system).   In addition, Commerce One is relied upon to teach selling of a

plurality of different tangible goods and services via an electronic procurement system.   Thus

the Examiner asserts one of ordinary skill in the art at the time of the invention would have

known to expand Commerce One to include as one of the plurality of goods and services offer to

include shipping services since it was known to sell shipping services in the same manner as

tangible goods (as taught by Williams).

Applicant goes on to assert that there is no motivation to combine Williams and

Commerce One. Specifically, Applicant challenges the cited portion of Williams (page 5 of 8,

1st paragraph). Examiner respectfully disagrees. The passage states that reducing the purchasing

costs of services improves a company's bottom line. Shipping services are clearly a services,

therefore one of ordinary skill would be motivated to want to purchasing shipping services from

a system such as Commerce One, which offers a plurality of goods and services.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, .

however, will the statutory period for reply expire later than SIX MONTHS from the mailing
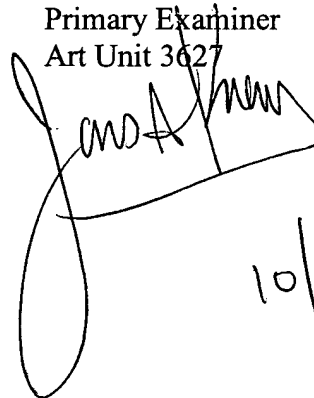
date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to James A. Kramer whose telephone number is (571) 272 6783.

The examiner can normally be reached on Monday - Thursday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Richard Chilcot can be reached on (571) 272 6777. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Kramer
Primary Examiner
Art Unit 3627

Jak
5/3/06

10/18/06